IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): A.J. Bradfield et al.
Case: SOM920030008US1
Serial No.: 10/699,036
Filing Date: October 31, 2003
Group: 2178
Examiner: Omar R. Abdul-Ali

Title: Methods and Apparatus for Making Web Browser Act Like Stand-Alone Application

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APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Sir:

Applicants (hereinafter referred to as "Appellants") hereby appeal the rejections of claims 1 and 5-7 of the above referenced application.

The fee previously paid with the prior Appeal Brief filed on November 30, 2007, should be applied to the present Appeal Brief, with the difference between the current fee and the amount previously paid charged to Deposit Account No. 09-0461.

REAL PARTY IN INTEREST

The present application is assigned to International Business Machines Corporation, as evidenced by an assignment recorded October 31, 2003 in the U.S. Patent and Trademark Office at Reel 14666, Frame 969. The assignee, International Business Machines Corporation, is the real party in interest.

RELATED APPEALS AND INTERFERENCES

There are no known related appeals and interferences.

STATUS OF CLAIMS

The present application was filed on October 31, 2003 with claims 1-20. Claims 2-4 and 8-20 have been canceled without prejudice in previous amendments. Claims 1 and 5-7 remain pending. Claim 1 is the pending independent claim.

Claims 1 and 5-7 stand rejected under 35 U.S.C. §103(a). Claims 1 and 5-7 are appealed.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 recites a method of processing a web page in a browser. The web page comprises a plurality of frames. The method comprises the step of displaying a first frame while loading a second frame and preventing a user from interacting with the first frame until after the second frame is sufficiently loaded. This prevention occurs after a determination is made that the first frame depends on the second frame. Otherwise, the method comprises the step of permitting the user to interact with the first frame regardless of whether the second frame is sufficiently loaded. The first frame is displayed until after the second frame is sufficiently loaded regardless of whether the user is permitted to interact with the first frame. The preventing step further comprises instructing the user to wait to interact with the first frame until after the second frame is sufficiently loaded.

An illustrative embodiment includes a method of processing a web page (e.g., Web Page in Storage Unit 106 in FIG. 1) in a browser (e.g., Web Browser 103 in FIG. 1), as described in the specification at, for example, page 5, lines 1-7. The web page comprises a plurality of frames, as described in the specification at, for example, page 7, line 9 ("a page may have two frames"). The method steps of displaying a first frame while loading a second frame and preventing a user from interacting with the first frame until after the second frame is sufficiently loaded (see, e.g., page 8, line 9, to page 9, line 7, with reference to FIG. 2, "[A] "live frame" [which can be a first frame] is

shown to the user . . . [i]f a dependency exists between Frame #1 and Frame #2, a check is made to determine whether Frame #2 is fully loaded (step 208) . . . [i]f not loaded, the user is instructed via an alert message to wait (step 209), while Frame #2 continues loading (step 210).”). This prevention occurs after a determination is made that the first frame depends on the second frame. (see, e.g., page 8, line 18 with reference to FIG. 2 “[T]he methodology checks if Frame #1 depends on Frame #2 (step 207).”). Otherwise, the method comprises the step of permitting the user to interact with the first frame regardless of whether the second frame is sufficiently loaded (see, e.g., page 8, lines 18-19 with reference to FIG. 2 “If no dependency is found, the user can be allowed to interact with Frame #1 (step 211).”). The first frame is displayed until after the second frame is sufficiently loaded regardless of whether the user is permitted to interact with the first frame. (see, e.g., page 8, line 5 to page 9, line 7, Frame #1 is displayed (as the “live frame”) whether or not the user is allowed to interact with it until Frame #2 is sufficiently loaded.). The preventing step further comprises instructing the user to wait to interact with the first frame until after the second frame is sufficiently loaded (see, e.g., page 8, lines 22-23 with reference to FIG. 2, “If not loaded, the user is instructed via an alert message to wait (step 209), while Frame #2 continues loading (step 210).”).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1 and 5-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,971,107 (hereinafter “Sjostrom”) in view of U.S. Patent No. 6,253,022 (hereinafter “Hobbs”).

ARGUMENT

Rejection of claims 1 and 5-7 under §103(a) over Sjostrom and Hobbs

Claims 1, 6 and 7

Appellants incorporate by reference herein the disclosures of all previous responses filed in the present application, namely, responses dated December 23, 2008, June 19, 2008, August 30, 2007, and April 5, 2007.

Regarding the §103(a) rejection of claims 1 and 5-7, Appellants respectfully reassert that claims 1 and 5-7 recite patentable subject matter for at least the reasons presented in Appellants' previous responses, as well as the reasons presented below.

Claim 1 includes a limitation directed to preventing a user from interacting with the first frame until after the second frame is sufficiently loaded, said prevention occurring after a determination is made that the first frame depends on the second frame, otherwise, permitting the user to interact with the first frame regardless of whether the second frame is sufficiently loaded. Claim 1 further specifies that the first frame is displayed until after the second frame is sufficiently loaded regardless of whether the user is permitted to interact with the first frame.

In formulating the present rejection, the Examiner acknowledges that Sjostrom fails to teach the limitations of claim 1 directed to preventing a user from interacting with the first frame until after the second frame is sufficiently loaded after a determination is made that the first frame depends on the second frame. Rather, the Examiner relies on column 31, lines 1-20, of Hobbs, which the Examiner characterizes as disclosing "the use of modal windows (frame) which prevents the user from interacting with an underlying application window (frame). The user must wait to interact with the application window until the modal frame is loaded and closed through user interaction." (internal citations omitted) Even assuming that the use of a modal window taught by Hobbs could be characterized as preventing a user from interacting with a first frame until after a second frame is sufficiently loaded, Appellants note that the relied-upon portion of Hobbs in fact teaches away from such a technique:

> The window is a semi-modal window, controlled and managed either by the embedded application or the scripted language, or by both. Semi-modal means that it has some characteristics of a modal window (it does not close automatically if one clicks in its background as typical pop-up windows do); yet unlike a modal window, it does not prevent activity in the background from taking place. For example, making a modal window appear in front of an applet would cause any buttons generated by the applet and appearing to the side of the window to freeze until the modal window is closed. In contrast, the semi-modal window permits buttons to be pressed in its background without causing it to close.

In other words, Hobbs suggests the desirability of a semi-modal window which "unlike a modal window, ... does not prevent activity in the background from taking place." As such, Hobbs teaches directly away from the limitation at issue in which a user is prevented from interacting with the first frame until after the second frame is sufficiently loaded.

Appellants respectfully submit that this is not a situation where "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004) Rather, one skilled in the art faced with the teachings of Hobbs reference which teaches the use of a semi-modal window which "unlike a modal window, ... does not prevent activity in the background from taking place," would clearly not look to modify the Hobbs arrangement such that a user is prevented from interacting with the first frame until after the second frame is sufficiently loaded in precisely the manner criticized by Hobbs. See, e.g., *In re ICON Health and Fitness Inc.*, 496 F.3d 1374, 1381, 83 USPQ2d 1746, 1751 (Fed. Cir. 2007) (quoting *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994)) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.")

Moreover, even assuming that Sjostrom could be characterized as teaching a technique in which a user is permitted to interact with the first frame regardless of whether the second frame is sufficiently loaded and that Hobbs could be characterized as teaching a technique in which a user is prevented from interacting with the first frame until after the second frame is sufficiently loaded, such teachings would nonetheless fail to meet the limitations of claim 1.

Specifically, as noted above, claim 1 recites a specific arrangement in which, after a determination is made that the first frame depends on the second frame, a user is prevented from interacting with the first frame until after the second frame is sufficiently loaded. Otherwise, i.e., if such a determination is not made, the user is permitted to interact with the first frame regardless of whether the second frame is sufficiently loaded.

Appellants respectfully submit that Sjostrom and Hobbs contain no teaching or suggestion directed to determining whether a first frame depends on the second frame, much less preventing or permitting user interaction with the first frame based on such a determination, as recited on claim 1. Indeed, both references teach away by instead disclosing techniques in which user interaction with a frame is entirely unrelated to whether that frame depends on another frame.

As recently noted by the Supreme Court, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR International Co. v. Teleflex Inc.*, 127 SCt 1727, 1741, 82 USPQ2d 1385, 1396 (U.S. 2007) Indeed, "when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." *Id.*, 127 SCt at 1740, 82 USPQ2d at 1395 (citing *United States* v. *Adams*, 383 U.S. 39, 51-52, 148 USPQ 479, 484 (1966)).

In view of the above, Appellants respectfully submit that the combination of Sjostrom and Hobbs fails to render claim 1 obvious.

Dependent claims 6 and 7 are allowable for at least the reasons identified above with regard to claim 1.

Claim 5

In addition to being patentable by virtue of its dependency from independent claim 1, claim 5 is also believed to define additional and separately-patentable subject matter. More particularly, dependent claim 5 includes a limitation wherein the second frame is sufficiently loaded when it is fully loaded. In other words, dependent claim 5 is directed to an arrangement in which a user is prevented from interacting with the first frame until after the second frame is fully loaded, said prevention occurring after a determination is made that the first frame depends on the second frame, otherwise, permitting the user to interact with the first frame regardless of whether the second frame is fully loaded.

In formulating the rejection of claim 5 in the final Office Action at page 4, second paragraph, the Examiner states (with emphasis in original) "Sjostrom and Hobbs disclose a system for making a web browser act like a stand-alone application as in Claim 1 above, and Sjostrom further discloses the second portion is sufficiently loaded when it is fully loaded (column 31, lines 1-20)."

Appellants respectfully submit that the Examiner's assertion that the limitations of claim 5 is taught by Sjostrom at column 31, lines 1-20, is clearly erroneous at least by virtue of the fact that there is no column 31 of Sjostrom. Appellants respectfully submit that this alone is sufficient to render the present rejection of claim 5 invalid. See, e.g., 37 CFR 1.104(c)(2) ("In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her

command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.") and MPEP 706.02(j) ("Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. . . . It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.") (citing *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n.3 (CCPA 1970))

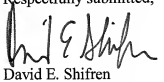
Assuming arguendo that the Examiner instead meant to cite to Hobbs at column 31, lines 1-20, which Appellants note is the portion of Hobbs relied upon by the Examiner in formulating the rejection of claim 1, Appellants submit that the present rejection remains substantively incorrect. Even assuming arguendo that Hobbs could be characterized as teaching a technique in which a user is prevented from interacting with the first frame until after the second frame is sufficiently loaded, there is simply no teaching or suggestion directed to a technique in which a user is prevented from interacting with the first frame until after the second frame is fully loaded.

More particularly, although Hobbs states that "making a modal window appear in front of an applet would cause any buttons generated by the applet and appearing to the side of the window to freeze until the modal window is closed," (and assuming arguendo that one could analogize the applet and modal window to the respective first and second frames recited in claim 1), there is no teaching or suggestion that the modal window could not be closed until after the modal window is fully loaded. One skilled in the art will understand that there are numerous instances of browser windows which can be closed by a user prior to their being fully loaded; many pop-up blockers employ this very technique.

Sjostrom fails to supplement the teachings of Hobbs so as to reach the limitations of claim 5, and hence claim 5 is believed to patentable over the cited combination of Sjostrom and Hobbs.

In view of the above, Appellants believe that claims 1 and 5-7 are in condition for allowance, and respectfully request withdrawal of the §103(a) rejection.

Respectfully submitted,



Date: May 4, 2009

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CLAIMS APPENDIX

1. A method of processing a web page in a browser, the web page comprising a plurality of frames, the method comprising the steps of:

displaying a first frame while loading a second frame; and

preventing a user from interacting with the first frame until after the second frame is sufficiently loaded, said prevention occurring after a determination is made that the first frame depends on the second frame, otherwise, permitting the user to interact with the first frame regardless of whether the second frame is sufficiently loaded;

wherein the first frame is displayed until after the second frame is sufficiently loaded regardless of whether the user is permitted to interact with the first frame; and

wherein the preventing step further comprises instructing the user to wait to interact with the first frame until after the second frame is sufficiently loaded.

5. The method of claim 1, wherein the second frame is sufficiently loaded when it is fully loaded.

6. The method of claim 1, wherein the browser is implemented on a client computer system.

7. The method of claim 1, wherein the browser comprises a web browser.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.